

Application/Control Number: 09/556,571
Art Unit: 3731

REMARKS

Claims

Applicant would like the Examiner to note that Claim 38 was cancelled without prejudice or disclaimer of the subject matter therein in the prior response dated February 18, 2003 to the office action dated August 15, 2002.

Please cancel claims 10, 25 and 26 without prejudice or disclaimer of the subject matter therein.

35 USC § 112

Claims 1-37 were rejected under 35 USC § 112, first paragraph for failure to comply with the written description requirement. Specifically the examiner found that limitations recited in independent claims 1 and 23 were not recited in the specification. Claims 1-37 were further rejected under 35 USC § 112, second paragraph.

Applicant has amended claims 1 and 23 to recite a wire which is distributed substantially equally along the length of the prosthesis. Support for this recitation can be found on page 20, lines 11-13.

Applicant submits that the amended claims provide sufficient description and specificity to the claimed invention. Claims 1-37 are now in compliance with 35 USC § 112 and withdrawal of rejection is respectfully requested.

35 USC § 102

Claims 1, 2, 8-16, 21, 23-32, 37 and 38 were rejected under 35 USC § 102 (b) as being anticipated by U.S. Patent No. 4,994,071 to MacGregor. Claims 10, 25 and 26 have been canceled without prejudice or disclaimer of the subject matter therein.

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Claim 38 was cancelled without prejudice or disclaimer of the subject matter therein in the prior response dated February 18, 2003 to the office action dated August 15, 2002.

Applicant asserts that independent claims 1 and 23 and dependent claims 8, 9, 24 and 25 are not anticipated by MacGregor. In order to anticipate, a cited reference must disclose each and every element. Applicant has amended claims 1 and 23 to recite a wire distributed substantially equally along the length of the prosthesis. MacGregor '071 does not disclose or teach a wire distributed substantially equally along the length of the prosthesis therefore it does not anticipate amended claims 1 and 23. Claims 2, 8-16, 21, 24-32, and 37 depend upon claims 1 and 23 and are therefore not anticipated by MacGregor '071 either.

For the reasons listed above applicant asserts that MacGregor '071 does not anticipate claims 1, 2, 8-16, 21, 23-32, 37 and 38 under 35 USC § 102 (b).

Claims 1-9, 17, 21, 23-25, 33 and 37 were rejected under 35 USC § 102 (b) as being anticipated by WO 95/09585 to Caro et. al. ("Caro"). Claims 10, 25 and 26 have been canceled without prejudice or disclaimer of the subject matter therein.

Applicant asserts that independent claims 1 and 23 and dependent claims 8, 9, 24 and 25 are not anticipated by Caro. Applicant has amended claims 1 and 23 to recite a wire distributed substantially equally along the length of the prosthesis. Caro does not disclose or teach a wire distributed substantially equally along the length of the prosthesis therefore it does not anticipate claims 1 or 23. Claims 2-9, 17, 21, 24-25, 33 and 37 depend upon claims 1 and 23 and are therefore not anticipated by Caro either.

For the reasons listed above applicant asserts that Caro WO 95/09585 does not anticipate claims 1-9, 17, 21, 23-25, 33 and 37 under 35 USC § 102 (b).

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Claims 1, 2, 4, 9, 10, 18, 19, 21-26, 34, 35 and 37 were rejected under 35 USC § 102 (b) as being anticipated by U.S. Patent No. 5,653,743 to Martin. Claims 10, 25 and 26 have been canceled without prejudice or disclaimer of the subject matter therein.

Applicant asserts that independent claims 1 and 23 and dependent claims 8, 9, 24 and 25 are not anticipated by Martin. Applicant has amended claims 1 and 23 to recite a wire distributed substantially equally along the length of the prosthesis. Martin '743 does not disclose or teach a wire distributed substantially equally along the length of the prosthesis therefore it does not anticipate claims 1 or 23. Claims 2, 4, 9, 10, 18, 19, 21-22, 24-26, 34, 35 and 37 depend upon claims 1 and 23 and are therefore not anticipated by Martin either.

For the reasons listed above applicant asserts that Martin '743 does not anticipate claims 1, 2, 4, 8, 9, 10, 18, 19, 21-26, 34, 35 and 37 under 35 USC § 102 (b).

Claims 1, 20, 23 and 36 were rejected under 35 USC § 102 (b) as being anticipated by U.S. Patent No. 5,156,619 to Ehrenfield.

Applicant asserts that independent claims 1 and 23 and dependent claims 20 and 36 are not anticipated by Ehrenfield. Applicant has amended claims 1 and 23 to recite a wire distributed substantially equally along the length of the prosthesis. Ehrenfield '619 does not disclose or teach a wire distributed substantially equally along the length of the prosthesis therefore it does not anticipate claims 1 or 23. Claims 20 and 36 depend upon claims 1 and 23 and are therefore not anticipated by Ehrenfield either.

For the reasons listed above applicant asserts that Ehrenfield '619 does not anticipate claims 1, 20, 23 and 36 under 35 USC § 102 (b).

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Claims 1, 20, 23 and 36 were rejected under 35 USC § 102 (b) as being anticipated by U.S. Patent No. 5,695,517 to Marin et. al.

Applicant asserts that independent claims 1 and 23 and dependent claims 20 and 36 are not anticipated by Marin. Applicant has amended claims 1 and 23 to recite a wire distributed substantially equally along the length of the prosthesis. Marin '517 disclose or teach a wire distributed substantially equally along the length of the prosthesis therefore it does not anticipate claims 1 or 23. Claims 20 and 36 depend upon claims 1 and 23 and are therefore not anticipated by Marin either.

For the reasons listed above applicant asserts that Marin '517 does not anticipate claims 1, 20, 23 and 36 under 35 USC § 102 (b).

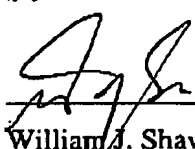
Allowance

For the aforementioned reasons, Applicant submits that this application is in condition for allowance. Applicant respectfully requests reconsideration of this application, the withdrawal of claim rejections and timely allowance of the pending claims.

Dated: December 24, 2003

Respectfully submitted,
SCIMED LIFE SYSTEMS

By: _____


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APPENDIX TO AMENDMENT

Version with Markings to Show Changes Made

Claim Amendments

Applicant would like the Examiner to note that Claim 38 was cancelled without prejudice or disclaimer of the subject matter therein in the prior response dated February 18, 2003 to the office action dated August 15, 2002.

Please cancel claims 10, 25 and 26 without prejudice or disclaimer of the subject matter therein.

Please amend the claims as follows:

- 1) (Twice Amended) An endoluminal prosthesis comprising:
a proximal end, a distal end and a hollow tubular body comprising a [biocompatible material] wire;
the hollow tubular body comprising at least one segment of curvature;
the segment of curvature comprising an inside of the curvature and an outside of the curvature;
wherein the [biocompatible material] wire is distributed substantially equally along the length of [the segment of curvature on the inside of the curvature and on the outside of the curvature] of the prosthesis.
- 11) (Amended) The prosthesis of claim [10] 1 wherein the wire comprises a shape memory alloy.
- 12) (Amended) The prosthesis of claim [10] 1 wherein the wire comprises a super elastic alloy.
- 13) (Amended) The prosthesis of claim [10] 1 wherein the wire comprises a polymer.

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- 14) (Amended) The prosthesis of claim [10] 1 wherein the wire is nitinol.
- 15) (Twice Amended) The prosthesis of claim [10] 1 wherein the wire is undulating.
- 16) (Amended) The prosthesis of claim [11] 1 wherein the wire is uniformly displaced along the length of the body.
- 23) (Twice Amended) An endoluminal prosthesis comprising:
a proximal end, a distal end and a hollow tubular body comprising a
[biocompatible material] wire;
the hollow tubular body comprising at least one segment of curvature;
the segment of curvature comprising an inside of the curvature and an outside of
the curvature;
wherein the [biocompatible material] wire is distributed substantially equally
along the length of [the segment of curvature on the inside of the curvature and on
the outside of the curvature] of the prosthesis;
and further wherein the hollow tubular body is geometrically shaped and sized to
approximate an anatomical shape.
- 27) (Amended) The prosthesis of claim [26] 23 wherein the wire comprises a shape-
memory alloy.
- 28) (Amended) The prosthesis of claim [26] 23 wherein the wire comprises a super-
elastic alloy.
- 29) (Amended) The prosthesis of claim [26] 23 wherein the wire comprises a
polymer.
- 30) (Amended) The prosthesis of claim [26] 23 wherein the wire is nitinol.
- 31) (Amended) The prosthesis of claim [26] 23 wherein the wire is undulating.

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- 32) (Amended) The prosthesis of claim [26] 23 wherein the wire is uniformly displaced along the length of the body.